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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/739,297 | 12/19/2000 | David L. Hecht | 07447.0006 | 3320 |

7590

10/19/2005

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EXAMINER

KIM, CHONG R

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,297

Applicant(s)

HECHT ET AL.

Examiner

Charles Kim

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on August 5, 2005 has been entered and made of record.
2. Applicant's arguments have been fully considered, but they are not deemed to be persuasive for at least the following reasons.

Applicants argue (page 5) that their claimed invention (claim 1) differs from the prior art because "nothing in column 7, lines 54-67 teach tiles having a common code pattern." The Examiner disagrees. In the cited portion of Petrie, it states "each of the frame blocks 72 contains a 16X16 array of glyphs, which are distributed on essentially uniformly spaced centers in accordance with a regular grid pattern." Note that each frame block (tile) comprises a 16X16 array of glyphs. Accordingly, the 16X16 array of glyphs in each frame block (tile) is interpreted as the code pattern common to the other tiles.

Applicants further argue (page 6) that "Petrie does not teach a predefined occlusion area having the same location and shape in the periodic tiles." The Examiner disagrees. Petrie clearly explains that the upper most row within each frame block (tile) is used for "ordinary user data" that is not necessary for decoding the code pattern. Accordingly, the predefined occlusion area has the same location (located at the upper most row of glyphs in each tile) and shape (fourteen glyphs) in the period tiles (frame block).

Applicants further argue (page 7) that their claimed invention (claim 7) differs from the prior art because "Hecht figures 5 and 6 show tiles (each having a common code pattern) that are not contagious." The Examiner disagrees. In figure 6, the blank areas in each tile are interpreted

Art Unit: 2623

as the occlusion strips. In that case, the occlusions appear to be contiguous across tile boundaries. Therefore, the combination of Petrie and Hecht appear to still be applicable to claim 7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrie, U.S. Patent No. 5,611,575 (“Petrie”).

Referring to claim 1, Petrie discloses an embedded data code on a substrate, comprising periodic tiles (72), each tile comprising:

a. a predefined code area having a code pattern common to other tiles (col. 7, lines 54-67)

b. a predefined occlusion area not necessary for decoding the code pattern (col. 10, line 65-col. 11, line 12. Note that the fourteen glyphs in the upper most row of glyphs in the tile include “ordinary user data” which is not necessary for decoding the code pattern).

Referring to claim 2, Petrie further discloses that each tile comprises glyphs (col. 7, lines 54-67).

Art Unit: 2623

Referring to claim 3, Petrie further discloses that the occlusion comprises a second code pattern (col. 11, lines 7-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Petrie, U.S. Patent No. 5,611,575 ("Petrie") and Hecht et al., U.S. Patent No. 6,000,621 ("Hecht").

Referring to claim 7, Petrie does not explicitly disclose that the occlusions are contiguous for occlusion strips spanning across tile boundaries. However, this feature was exceedingly well known in the art. For example, Hecht discloses embedded data code on a substrate comprising occlusions that are contiguous for occlusion strips spanning across tile boundaries (figure 6).

Petrie and Hecht are combinable because they are both concerned with embedding data code on a substrate. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the occlusions of Petrie so that they are contiguous for occlusion strips spanning across tile boundaries, as taught by Hecht. The suggestion/motivation for doing so would have been enhance the flexibility of the data encoded substrate by providing

multiple code pattern configurations. Therefore, it would have been obvious to combine Petrie with Hecht to obtain the invention as specified in claim 7.

Allowable Subject Matter

5. Claims 4-6, 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2623

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 571-272-7421. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

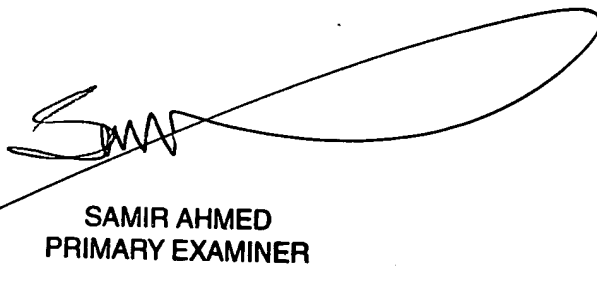
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ck

October 16, 2005



**SAMIR AHMED
PRIMARY EXAMINER**